

REMARKS

This amendment is in response to the Office Action of March 15, 2006.

Claims 1 through 13 and 15 through 21 are currently pending in the application.

Claim 14 was previously canceled herein.

Claims 1, 15, 20, and 21 have been amended herein.

Support for the amendments may be found throughout the specification and particularly in paragraph [0062]. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are to clearly distinguish over the cited art. The amendments are made without prejudice or disclaimer.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent 6,965,958 to Wood *et al.* and U.S. Patent 6,738,841 to Wolff

Claims 1 through 13 and 15 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood *et al.* (U.S. Patent 6,965,958) (hereinafter “Wood”) and Wolff (U.S. Patent 6,738,841) (hereinafter “Wolff”). Applicant respectfully traverses these rejections, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Regarding presently amended independent claim 1, Applicant asserts that Wood and Wolff, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Wood and Wolff do not

teach or suggest the claim limitation of the claimed invention calling for “translating said data from rasterized images into a format compatible with a software application used to create said data.” Applicant asserts that Wood teaches that “[d]ocuments can be edited, reordered, merged, deleted and annotated.” *Col. 3, lines 42-43.* Applicant asserts that Wood does not teach that data may be stored in the job retention memory in a rasterized image. Applicant asserts that Wood does not teach translating the rasterized images. Applicant asserts that Wood does not teach translating to a format compatible with the software application used to create the data. Wolff does not cure the deficiencies of Wood. Therefore, for at least these reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 1 is allowable.

Claims 2 through 13 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Regarding presently amended independent claim 15, Applicant asserts that Wood and Wolff, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 15 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Wood and Wolff do not teach or suggest the claim limitation of the claimed invention calling for “managing said data comprising transforming said data from rasterized images into a format in which said data was originally received by said printing device.” Applicant asserts that Wood teaches that “[d]ocuments can be edited, reordered, merged, deleted and annotated.” *Col. 3, lines 42-43.* Applicant asserts that Wood does not teach that data may be stored in the job retention memory in a rasterized image. Applicant asserts that Wood does not teach transforming the rasterized images. Applicant asserts that Wood does not teach transforming to a format in which the data was originally received by the printing device. Wolff does not cure the deficiencies of Wood. Therefore, for at least these reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 15 is allowable.

Claims 16 through 19 are allowable for at least the reason of depending from allowable presently amended independent claim 15.

Regarding presently amended independent claim 20, Applicant asserts that Wood and Wolff, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 20 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Wood and Wolff do not teach or suggest the claim limitation of the claimed invention calling for “managing said data comprising translating said data from a RIP’ed format into a format compatible with a software application used to create said data.” Applicant asserts that Wood teaches that “[d]ocuments can be edited, reordered, merged, deleted and annotated.” *Col. 3, lines 42-43.* Applicant asserts that Wood does not teach that data may be stored in the job retention memory in a RIP’ed format. Applicant asserts that Wood does not teach translating the RIP’ed format. Applicant asserts that Wood does not teach translating to a format compatible with a software application used to create the data. Wolff does not cure the deficiencies of Wood. Therefore, for at least these reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 20 is allowable.

Regarding presently amended independent claim 21, Applicant asserts that Wood and Wolff, even if combined, do not teach or suggest all of the claim limitations of presently amended independent claim 21 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Wood and Wolff do not teach or suggest the claim limitation of the claimed invention calling for “managing said data comprising translating said data from a RIP’ed format into a format compatible with a software application used to create said data.” Applicant asserts that Wood teaches that “[d]ocuments can be edited, reordered, merged, deleted and annotated.” *Col. 3, lines 42-43.* Applicant asserts that Wood does not teach that data may be stored in the job retention memory in a RIP’ed format. Applicant asserts that Wood does not teach translating the RIP’ed format. Applicant asserts that Wood does not teach translating to a format compatible with a software application used to create the data. Wolff does not cure the deficiencies of

Wood. Therefore, for at least these reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 21 is allowable.

Applicant asserts that claims 1 through 13 and 15 through 21 are clearly allowable over the cited art.

Applicant requests the allowance of claims 1 through 13 and 15 through 21 and the case passed for issue.

Respectfully submitted,



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